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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,226	11/14/2001	Raymond Anthony Joao	RJ371	6756

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EXAMINER

NAJARIAN, LENA

ART UNIT	PAPER NUMBER
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3626

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03/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/987,226	Applicant(s) JOAO, RAYMOND ANTHONY	
	Examiner LENA NAJARIAN	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 50-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 50-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080219</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Request for Continued Examination (RCE) filed 2/19/08. Claim 1 has been amended. Claims 9, 25, and 33-49 have been cancelled. Claims 50-68 are newly added. Claims 1 and 50-68 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/08 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 50-63 and 65-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Knaus et al. (US 2002/0004727 A1).

(A) Referring to claim 50, Knaus discloses a computer-implemented method, comprising (abstract of Knaus):

processing a request by an entity to obtain information contained in a patient's healthcare record, with a processor (para. 22 of Knaus);

generating a message containing information regarding the entity making the request (para. 58 of Knaus; the Examiner interprets transmitting a "notice" to be a form of "message"), and further wherein the message contains information regarding a reason for the request (para. 58 of Knaus); and

transmitting the message to a communication device of the patient via a communication network, wherein the message is transmitted to the communication device of the patient prior to a completion of an obtaining of the information contained in a patient's healthcare record by the entity (para. 21 and para. 58 of Knaus).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

(B) Referring to claim 51, Knaus discloses receiving a response to the message, wherein the response to the message is transmitted from the communication device of the patient, and further wherein the response to the message contains information for terminating or denying an obtaining of the information contained in a patient's healthcare record; and terminating or denying the request to obtain

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the information contained in a patient's healthcare record (para. 43 and para. 58 of Knaus).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

(C) Referring to claim 52, Knaus discloses receiving information regarding an examination finding, wherein the information regarding an examination finding is transmitted from a computer associated with a healthcare provider of the patient; storing and processing the information regarding an examination finding; and updating the information contained in a patient's healthcare record to include the information regarding an examination finding (para. 46 of Knaus).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

(D) Referring to claim 53, Knaus discloses wherein the information regarding an examination finding contains information obtained by a monitoring device (para. 60 of Knaus).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

(E) Referring to claim 54, Knaus discloses performing a diagnostic evaluation of the patient using the information regarding an examination finding (para. 46 and para. 47 of Knaus);

generating a second message in response to the diagnostic evaluation, wherein the second message contains a diagnosis or a list of possible diagnoses (para. 46 of Knaus);

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transmitting the second message to the computer associated with a healthcare provider of the patient (para. 46 and para. 47 of Knaus); and
updating the information contained in a patient's healthcare record to include information contained in the second message (para. 47 of Knaus).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

(F) Referring to claim 55, Knaus discloses generating a third message in response to the diagnostic evaluation, wherein the third message contains information regarding a treatment corresponding to the diagnosis or the list of possible diagnoses (para. 45 of Knaus);

transmitting the third message to the computer associated with a healthcare provider of the patient (para. 47 of Knaus);

updating the information contained in a patient's healthcare record to include information contained in the third message (para. 45 of Knaus).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

(G) Referring to claim 56, Knaus discloses receiving information regarding a treatment to be administered to the patient, wherein the information regarding a treatment to be administered to the patient is transmitted from a computer located at a healthcare facility (para. 45 and para. 52 of Knaus);

processing the information regarding a treatment to be administered to the patient using the information contained in a patient's healthcare record (para. 52 of Knaus);

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determining whether or not the treatment to be administered to the patient is correct (para. 54 and para. 41 of Knaus);

generating a second message containing information regarding whether or not the treatment to be administered to the patient is correct, and, if the treatment to be administered to the patient is determined to be not correct, the second message contains information regarding a correct treatment (para. 41 and para. 43 of Knaus); and

transmitting the second message to the computer located at a healthcare facility (para. 52 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(H) Referring to claim 57, Knaus discloses determining whether a diagnosis is appropriate (para. 46 of Knaus);

generating a second message containing information regarding whether a diagnosis is appropriate or valid (para. 46 of Knaus); and

transmitting the second message to a computer associated with a healthcare payer (para. 59 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(I) Referring to claim 58, Knaus discloses wherein the communication device of the patient is a wireless device, and further wherein the message is transmitted to the communication device of the patient via the World Wide Web (para. 39 of Knaus).

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Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(J) Referring to claim 59, Knaus discloses transmitting the message to a computer associated with a healthcare provider of the patient (para. 43 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(K) Referring to claim 60, Knaus discloses transmitting the message to a computer associated with a healthcare payer (para. 59 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(L) Referring to claim 61, Knaus discloses generating a second message containing information regarding a diagnosis regarding the patient (para. 46 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(M) Referring to claim 62, Knaus discloses generating a second message containing information regarding an occurrence of an admitting of the patient to a hospital (para. 46 of Knaus);

transmitting the second message to a computer associated with a healthcare payer (para. 59 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

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(N) Referring to claim 63, Knaus discloses generating a second message containing information regarding an insurance claim for submission to a healthcare payer, wherein the second message is automatically generated in response to an updating of the information contained in a patient's healthcare record (para. 62 and para. 45 of Knaus);

transmitting the second message to a computer associated with a healthcare payer of the patient (para. 62 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(O) Referring to claim 65, Knaus discloses receiving and storing information for updating the information contained in a patient's healthcare record, wherein the information for updating the information contained in a patient's healthcare record is transmitted from the communication device used by the patient (para. 22 and para. 60 of Knaus).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

(P) Referring to claim 66, Knaus discloses receiving and storing information for updating the information contained in a patient's healthcare record, wherein the information for updating the information contained in a patient's healthcare record is transmitted from a computer associated with a healthcare provider of the patient (para. 43 of Knaus); and

updating the information contained in a patient's healthcare record (para. 20 of Knaus).

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Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al. (5,867,821) in view of Knaus et al. (US 2002/0004727 A1), and further in view of Elkind (US 2003/0158754 A1).

(A) Referring to claim 1, Ballantyne discloses an apparatus, comprising (abstract of Ballantyne):

a processor, wherein the processor processes a request to access information contained in a patient's healthcare record, wherein the processor determines whether an individual is authorized to access the information contained in a patient's healthcare record, and further wherein the processor generates a notification report containing information regarding identification information regarding the individual (col. 7, line 67 – col. 8, line 60, col. 15, lines 22-39, col. 16, lines 7-13, and col. 12, lines 35-57 of Ballantyne); and

a transmitter, wherein the transmitter transmits the notification report to a patient communication device via a communication network (col. 7, line 67 – col.

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8, line 60, col. 15, lines 22-39, col. 16, lines 7-13, and col. 12, lines 35-57 of Ballantyne).

Ballantyne does not expressly disclose further wherein the notification report is transmitted to the patient communicative device at least one of during, concurrently with, at a same time as, and prior to a completion of, an at least one of an accessing, an obtaining, a changing, an altering, and a modifying, of the information contained in a patient's healthcare record or a patient's healthcare file by the individual or entity, or at least one of during, concurrently with, at the same time as, and prior to a completion of, a processing of the request.

Ballantyne also does not expressly disclose further wherein the notification report contains information regarding a reason for the request, and further wherein the notification report contains at least one of information regarding a nature of any change, alteration, or modification, sought to be made or made to information contained in a patient's healthcare record or a patient's healthcare file, and information regarding a subject of a change, alteration, or modification, sought to be made or made to the information contained in a patient's healthcare record or a patient's healthcare file.

Knaus discloses further wherein the notification report contains information regarding a reason for the request (para. 58 of Knaus; the Examiner interprets an "investigation" to be a form of "reason for the request") and the notification report is transmitted to the patient communicative device of the patient prior to a completion of an obtaining of the information contained in a patient's healthcare record by the individual (para. 58 of Knaus).

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Elkind discloses sending a notification containing information regarding a nature of any alteration sought to be made to information contained in a patient's healthcare record (para. 45 and para. 46 of Elkind).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Knaus and Elkind within Ballantyne. The motivation for doing so would have been to provide a secure access to a patient's own medical record only by said patient and those users designated and authorized by said patient (para. 21 of Knaus) and to ensure that the information in the system is maintained in tact (para. 45 of Elkind).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

7. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knaus et al. (US 2002/0004727 A1) in view of Mayaud (5,845,255).

(A) Referring to claim 64, Knaus discloses wherein the message contains information regarding the entity making the request and a reason for the request (para. 58 of Knaus), and information regarding a subject of an alteration sought to be made to the information contained in a patient's healthcare record (para. 43 of Knaus).

Knaus does not expressly disclose a time and date of the request.

Mayaud discloses a time and date of the request (see col. 17, line 60 – col.18, line 5 of Mayaud).

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Mayaud within Knaus. The motivation for doing so would have been to ensure a high level of confidentiality (col. 17, lines 60-62 of Mayaud).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

8. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knaus et al. (US 2002/0004727 A1) in view of Ballantyne et al. (5,867,821).

(A) Referring to claim 67, Knaus discloses transmitting information regarding the accessing of a patient's record to a computer associated with the patient (see para. 43-44 and para. 58 of Knaus).

Knaus does not expressly disclose generating an activity report containing information regarding an accessing of the information contained in a patient's healthcare record during a time period, in response to a request to receive an activity report.

Ballantyne discloses generating an activity report containing information regarding an accessing of the information contained in a patient's healthcare record during a time period, in response to a request to receive an activity report (col. 8, lines 5-60 of Ballantyne).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Ballantyne within Knaus. The motivation for doing so would have been to ensure privacy by

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having the patient be informed of who has accessed their health records (col. 8, lines 5-10 of Ballantyne).

Insofar as the claim recites “at least one of” or “or,” it is immaterial whether or not the other elements are also disclosed.

9. Claim 68 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al. (5,867,821) in view of Knaus et al. (US 2002/0004727 A1), (A) Referring to claim 68, Ballantyne discloses a computer-implemented method, comprising (abstract of Ballantyne):

receiving information regarding a restriction regarding an ability of a person to access information contained in a patient’s healthcare record, wherein the restriction contains information regarding a healthcare provider, and information regarding a designated purpose for allowing each of a healthcare provider to access the information contained in a patient’s healthcare record (col. 8, lines 7-43 of Ballantyne), wherein the designated purpose is to perform a diagnosis (col. 10, lines 10-23 of Ballantyne);

storing the information regarding a restriction regarding an ability of a person to access the information contained in a patient’s healthcare record (col. 8, lines 20-28 of Ballantyne);

processing a request by a person to access the information contained in a patient’s healthcare record (col. 8, lines 28-50 of Ballantyne);

determining, using the information regarding the restriction, whether the person is authorized to access the information contained in a patient's healthcare record (col. 8, lines 28-50 of Ballantyne);

Ballantyne does not expressly disclose generating a message containing information regarding the entity making the request, and further wherein the message contains information regarding a reason for the request ; and transmitting the message to a communication device of the patient via a communication network, wherein the message is transmitted to the communication device of the patient prior to a completion of an obtaining of the information contained in a patient's healthcare record by the entity.

Knaus discloses generating a message containing information regarding the entity making the request (para. 58 of Knaus; the Examiner interprets transmitting a "notice" to be a form of "message"), and further wherein the message contains information regarding a reason for the request (para. 58 of Knaus); and transmitting the message to a communication device of the patient via a communication network, wherein the message is transmitted to the communication device of the patient prior to a completion of an obtaining of the information contained in a patient's healthcare record by the entity (para. 21 and para. 58 of Knaus).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Knaus within Ballantyne. The motivation for doing so would have been to provide a secure

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access to a patient's own medical record only by said patient and those users designated and authorized by said patient (para. 21 of Knaus).

Insofar as the claim recites "at least one of" or "or," it is immaterial whether or not the other elements are also disclosed.

Response to Arguments

10. Applicant's arguments filed 2/19/08 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 2/19/08.

(1) Applicant argues that Ballantyne, Knaus, and any combination of same, do not disclose, teach, or suggest, the recited notification report. Applicant submits that Ballantyne, Knaus, and any combination of same, do not disclose, teach, or suggest, the recited message. Applicant submits that Ballantyne, Knaus, and any combination of same, do not disclose, teach, or suggest, the recited restriction or limitation.

(A) As per the first argument, the Examiner is concerned that, aside from merely alleging that certain claimed features are not obvious from Ballantyne and Knaus, essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the reference and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes

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them from the reference does not comply with the requirements of this section."

Applicant has failed to specifically point out **HOW** the language of the claims patentably distinguishes them from the applied reference. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches an individualized patient electronic medical records system (US 6,523,009 B1); a system and method for providing personal control of access to confidential records over a public network (US 2004/0199765 A1); and a method and system for assimilating data from disparate, ancillary systems onto an enterprise system (US 2003/0074248 A1).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571) 272-6770. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. N./
Examiner, Art Unit 3626
In
3/14/08

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626